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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/533,361 03/22/00 TOUMI

B 6388-0501-0

EXAMINER

HM22/0815

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WELLS

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

08/15/01

Please find below and/or attached an Office communication concerning this application proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/533,361

Applicant(s)

TOUMI ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

The election of species of December 4, 2000 (Paper No. 4) is hereby withdrawn. Claims 1-19 were searched in their entirety.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter in question is draining, lipolytic, disinfiltrating, slimming, firming, antiglycant, and vasoprotective compounds. These compounds are not known in the art and the specification does not define them.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 5, 11, 17, 29, 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 3 is vague and indefinite, as it is not clear what is being used in the method of manufacturing a composition. Is it a method of using a composition being claimed? Is it a method of using the grafted silicone polymer? Is it something else?

(ii) A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 3 recites the broad recitation "remove signs of cutaneous ageing", and the claim also recites "in particular to reduce or remove wrinkles and/or fine lines of the skin and/or to smooth out the skin" which is the narrower statement of the range/limitation; claim 17 recites the broad recitation "exhibits at least one. . . of the following characteristics", and the claim also recites "preferably all of the following characteristics" which is the narrower statement of the range/limitation; claim 19 recites the broad recitation "grafted silicone polymer represents from 0.03-25%", and the claim also recites "preferably from 0.3 to 6%" and "better still approximately 2%" which is the narrower statement of the range/limitation; claim 23 recites the broad recitation "treatment of aged skin", and the claim also recites "in particular wrinkled skin" which is the narrower statement of the range/limitation

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(iii) The term "type" in claim 5 (line 7), 17 (lines 6 and 8), 18 (line 4) is vague and indefinite, as it is not clear what other compounds or constituents are encompassed by this phrase.

(iv) Claim 11 is vague and indefinite, as it is not clear what the result of the radical copolymerization is. Is it between the anionic and/or hydrophobic monomers and the silicone? Is it between the anionic and hydrophilic monomers? Is it between something else?

(v) The phrase "exhibiting" in claim 11 is vague and indefinite, as it is not clear what this phrase means. Does it mean that the monomers and silicone, in their chemical structure, contain the features that are exhibited or does it mean that something is done to the monomers to cause them to have the features that are exhibited?

(vi) The term "derivative" in claim 22 (line 3) is vague and indefinite, as it is not clear what compounds are encompassed by this phrase.

(vii) The phrase "draining, lipolytic, disinfiltrating, slimming, firming, antiglycant and/or vasoprotective compounds" in claim 21 (lines 4-5) is vague and indefinite, as it is not clear what these compounds are. The specification fails to define these terms and one of ordinary skill in the art would not be appraised of them.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-8, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hutchins et al. (WO 98/09608).

Hutchins et al. teach personal care compositions comprising a copolymer complex for hair care and skin care use. The copolymer disclosed is a grafted silicone polymer comprising a polysiloxane portion, a portion composed of a non-silicone organic chain, wherein one of the two portions constitutes the main chain of the polymer and the other is grafted to the main chain. Skin soothing agents disclosed for use in the composition are clove oil, eucalyptus oil, and witch hazel distillate (extracts of plant proteins). The composition is disclosed as having anti-wrinkling benefits. See pg. 5-pg. 16; pg. 18-pg. 32; pg. 47-end.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutchins et al. in view of Sebang et al. (6,162,423) and Dubief et al. (6,011,126) in further view of Sidhu (4,963,353).

Hutchins et al. fail to teach the preferred polymer of claim 9, a polysiloxane polymer comprising anionic and/or hydrophobic non-silicone monomers, and plant proteins (see discussion above).

Sebang et al. teach washing and conditioning compositions containing silicone and dialkyl ether. Disclosed is a foaming composition for washing and conditioning keratinous materials, particularly hair and/or skin. Disclosed is a polymer comprising 50-90% tert-butyl acrylate, 0-40% acrylic acid, and 5-40% of the silicone macromer of formula (III) of the instant invention. Further disclosed polysiloxane units are polyorganosilixanes containing thiol groups. See Col. 1, line 7-Col. 7, line 10; Col. 17, line 17-Col. 24, line 10.

Dubief et al. teach compositions for treating keratinous material, including at least one silicone-grafted polymer and at least one fatty chain amide, and uses thereof. Disclosed is a grafted silicone polymer comprising from 0-98% of at least one lipophilic monomer, from 0-98% of at least one polar hydrophilic monomer, and from 0.01-50% of at least one polysiloxane macromer. Disclosed as a particularly preferred embodiment of the invention is a polymer with a polysiloxane backbone grafted by at least one non-silicone organic monomer, wherein the polymer comprises the result of a radical copolymerization between, on the one hand, at least one anionic non-silicone organic monomer exhibiting ethylenic unsaturation and/or one hydrophobic non-silicone organic monomer exhibiting an ethylenic unsaturation and, on the other hand, a silicone exhibiting, in its chain, at least one functional group capable of reacting with the said ethylenic unsaturations of the said non-silicone monomers with the formation of a covalent bond. Formula (III) and formula (IV) of the instant invention are disclosed as polysiloxane macromers. A copolymer comprising 60% tert-butyl acrylate, 20% acrylic acid,

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and 20% of a silicone macromer of formula (III) is disclosed. See Col. 2, line 55-Col. 18, line 15.

Sidhu teach biological extracts for regenerating/tightening the skin. The invention is directed toward algal extracts and the background discloses horse chestnut extract. See Col. 1, line 10-Col. 8, line 10.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the grafted silicone polymer of Hutchins et al. using the teachings of Sebang et al. and obtain a grafted silicone polymer comprising 60% tert-butyl acrylate, 20% acrylic acid, and 20% of a silicone macromer of formula (III) because a) Hutchins et al. and Sebang et al. both teach personal care compositions comprising grafted silicone polymers for revitalizing skin and hair; b) Hutchins et al. and Sebang et al. both teach grafted silicone polymers comprising lipophilic monomers with ethylenic unsaturation, hydrophilic monomers with ethylenic unsaturation, and polysiloxanes. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modified the invention of the combined references using the teachings of Dubief et al. and obtain a polymer with a polysiloxane backbone grafted by at least one non-silicone organic monomer because a) the combined references and Dubief et al. all teach personal care compositions comprising grafted silicone polymers as active agents for use on keratinous substances; b) Dubief et al. teach the grafted silicone polymers of Hutchins et al. and Seban et al. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of the combined references using the teachings of Sidhu and obtain a composition comprising a silicone graft copolymer and plant proteins because a) Hutchins et al., Sebang et

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al., and Sidhu all teach personal care compositions for revitalizing the skin and hair; b) Hutchins et al. and Sidhu both teach compositions for use against wrinkles.

The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references. Therefore, the claims are properly rejected under 35 U.S.C. § 103.

Notes/Comments

(i) The Examiner respectfully suggests that the Applicant consistently use the *same* Markush language for claims that contain Markush groups.

(ii) The Examiner respectfully suggests that the Applicant replace the phrase “their mixtures” with the phrase “mixtures thereof”

Prior Art

The prior art made of record and not specifically relied upon in any rejections cited above is either 1) considered cumulative to the prior art that was cited in a rejection or is 2) considered pertinent to the applicant’s disclosure and shows the state of the art in its field but is not determined by the Examiner to read upon the invention currently being prosecuted in this application.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
July 2, 2001



DAMERON L. JONES
PRIMARY EXAMINER